



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|--|-------------|----------------------|-----------------------------|------------------------|
| 10/650,410   | 08/28/2003  | Klausjoerg Klein     | FA1151 US NA                | 6546                   |
| 23906 7590 05/25/2007<br>E I DU PONT DE NEMOURS AND COMPANY<br>LEGAL PATENT RECORDS CENTER<br>BARLEY MILL PLAZA 25/1128<br>4417 LANCASTER PIKE<br>WILMINGTON, DE 19805 |             |                      | EXAMINER<br>MAYEKAR, KISHOR |                        |
|  |             |                      | ART UNIT<br>1753            | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>05/25/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/650,410 | <b>Applicant(s)</b><br>KLEIN ET AL. |  |
|                              | <b>Examiner</b><br>Kishor Mayekar    | <b>Art Unit</b><br>1753             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's affirmation of the election of Group I, claims 1-11 in the reply filed on 15 March 2007 is acknowledged.

2. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection

#### *Claim Rejections - 35 USC § 102 and § 103*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments

Art Unit: 1753

Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 4-8 and 11 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Martin et al. (US 6,841,199 B2). Martin's invention is directed to a method for inhibiting corrosion by post-dip of coated parts. Martin discloses that the method comprises coating a metal substrate, wherein the coating is by electrocoating, and contacting the coated substrate with a composition comprising one or more yttrium, titanium and the rare-earth elements, wherein the contacting can be performed either before or after the coating is cured (see abstract and col. 3, lines 34-42). In Examples 3 and 5, Martin further discloses the step of rinsing the coated substrate prior to the contacting.

As to the subject matter of each of claims 5-8, Martin discloses it in Examples, col. 2, lines 15-28 and col.4, lines 60-63

6. Claims 3 and 9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Martin '199. Martin as applied above further discloses in col. 2, lines 39-49 the concentration of the composition. It has been

Art Unit: 1753

held that the disclosure in the prior art of any value within the claimed range is an anticipation of that range. And a prima facie case of obviousness exists in the case where the claimed range overlaps range disclosed by the prior art, *In re Wertheim* 191 USPQ 90.

As to claim 9, since Martin's composition contains the recited metal compound in a concentration overlapping the recited range, at least Martin's contacting inherently possesses the recited subject matter.

7. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over December (US 6,342,144 B1) in view of either Kaylo (US 4,421,620) or Misawa (US 4,870,715). December's invention is directed to a process for the production of a cured multilayer coating. December discloses that the method comprises the recited steps a), c) and d) wherein in step c) the aqueous preparation contains tin or bismuth carboxylate (see abstract; col. 20, lines 55-62 and col. 27, lines 5-20). The difference between December and the above claims is the provision of the recited step b). Kaylo shows in a process for the production of a cured multilayer coating the limitation (Example IB). Misawa shows the same in a process for the production of a cured multilayer coating (all Examples). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified December's teachings as shown by either Kaylo or Misawa because this would result in removing excess and non-adhering coating composition.

*Response to Arguments*

8. Applicant's arguments filed 15 March 2007 have been fully considered but they are not persuasive because of the new grounds of rejections as set forth in the paragraphs above.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1753

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Kishor Mayekar  
Primary Examiner  
Art Unit 1753